



#22

PATENT
Attorney Docket No. UCSD-04742

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Roman Sakowicz *et al.*
Serial No.: 09/235,416
Filed: 01/22/99
Entitled: **Identification and Expression of
a Novel Kinesin Motor Protein**

Group No.: 1645
Examiner: Ja-Na Hines

**RENEWED PETITION UNDER 37 C.F.R. § 1.137(a) TO
REVIVE ABANDONED APPLICATION FOR
UNAVOIDABLE DELAY**

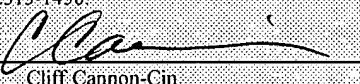
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 CFR § 1.8(a)(1)(i)(A)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 6, 2003

By: _____


Cliff Cannon-Cin

Sir/Madam:

Further to the Office's July 14, 2003 decision on Petition, Applicants respectfully renew their petition to the Commissioner pursuant to 37 C.F.R. §1.137(a) to (A) revive the above-identified patent application for unavoidable delay in reply by applicant, (B) refund the RCE filing fee of \$375.00, and (C) expedite examination of the application upon grant of this Petition.

A. PETITION TO REVIVE FOR UNAVOIDABLE DELAY

Pursuant to 1.137(a), enclosed are:

(1) The Response to the outstanding Office action (Restriction Requirement) which was originally mailed by the Office on 4/23/01, and a copy of which was forwarded by the Office to the Applicants as part of the 7/14/03 decision on Petition;

(2) The petition fee set forth in 37 C.F.R. §1.17(l);

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(3) Copy of the 7/14/03 decision on Petition, showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. In particular, the enclosed document states that "Petitioner has sufficiently established that a change of correspondence address was timely submitted."¹

(4) A terminal disclaimer is not required as stated in the enclosed copy of the 7/14/03 decision on Petition, page 2, second paragraph.

B. PETITION TO REFUND FEE

In reviewing Applicant's Petition under 37 C.F.R. §1.182 that was mailed on 2/14/03, the Office stated in its 7/14/03 decision on Petition that "the fee for a Request for continued Examination (RCE) was also charged to petitioner's credit card. As the instant application is not currently eligible for RCE practice, petitioner may wish to request a refund of this \$375.00."² Applicants hereby petition a refund of this \$375.00.

C. PETITION TO EXPEDITE EXAMINATION

The 7/14/03 decision on Petition stated that "a change of correspondence address was timely submitted."³ Thus, despite Applicants' timely and express instructions, the USPTO improperly mailed the Office Action to the prior law firm, whose power of attorney was revoked. Since the Office agreed that abandonment of this application was due to the Office's error, Applicants request that examination of this application be expedited.

The Commissioner is hereby authorized to charge any fees associated with filing this Petition (including the fee under 37 CFR § 1.17(l)) or credit overpayment to our Deposit

¹ 7/14/03 Decision on Petition, page 2, second paragraph.

² 7/14/03 Decision on Petition, paragraph bridging pages 1 and 2.

³ 7/14/03 Decision on Petition, page 2, second paragraph.

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Account No. 08-1290. An originally executed duplicate of this transmittal is enclosed for this purpose.

Signed on behalf of:

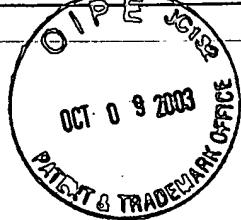
Dated: 10-6-03

Maha Hamdan

Maha A. Hamdan
Registration No. 43,655
MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
415-904-6500



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JUL 18 2003

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Paper No. 221

MEDLEN & CARROLL, LLP
101 HOWARD STREET
SUITE 350
SAN FRANCISCO, CA 94105

JUL 14 2003

In re Application of
Sakowicz, et al.
Application No. 09/235,416
Filed: January 22, 1999
Attorney Docket No.: UCSD-04742

: OFFICE OF PETITIONS
: ON PETITION
:
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This is a decision on the petition under 37 CFR 1.182, filed February 21, 2003, to revive the above-identified application. Revival of applications for patents is governed by the provisions of 37 CFR 1.137. Accordingly, this petition is being treated under 37 CFR 1.137(a) for revival of an unavoidably abandoned application.

The petition is **DISMISSED**. *9/14/03 RWD*

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned May 24, 2001 for failure to timely reply to the Office communication mailed April 23, 2001. The Office communication set a one month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely procured. Notice of Abandonment was mailed November 2, 2001.

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

As to item (1), the instant petition lacks the required reply to the outstanding Office communication. Enclosed please a copy of the Office communication for petitioner's review. Any renewed petition must be accompanied by a proper reply.

As to item (2), it is noted that \$55.00, the small entity fee for a petition under 37 CFR 1.137(a) was previously charged to petitioner's credit card. As a loss of entitlement to small entity status was filed February 28, 2002, the remaining fee of \$55.00 has been charged to Deposit Account No. 08-1290 as authorized in the instant petition. It is further noted that it would appear that the fee for a Request for Continued Examination

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(RCE) was also charged to petitioner's credit card. As the instant application is not currently eligible for RCE practice, petitioner may wish to request a refund of this \$375.00 if appropriate. As to petitioner's contention that a fee should not be assessed in this matter, petitioner is advised that the Office is not at liberty to waive or refund the petition fee as submission of the petition fee is a prerequisite for treatment on the merits of the instant petition under 37 CFR 1.137(a)(2).

As to item (3), where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. See, MPEP 711.03(c). Petitioner has sufficiently established that a change of correspondence address was timely submitted.

Item (4) is inapplicable to the instant application.

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 308-6916
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Office Communication



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

(CH)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/235,416 01/22/99 SAKOWICZ

R 18557C-7-1

020350. HM12/0423
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER

HINES, J
ART UNIT

PAPER NUMBER

1645

DATE MAILED:

04/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/235,416	SAKOWICZ ET AL	
	Examiner Ja-Na A Hines	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 59-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims 59-101 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 59-68 are drawn to a method of screening modulators providing a biologically active TL-gamma, classified in class 435, subclass 7.4.
 - II. Claims 69-78 are drawn to a method of screening modulators wherein the tail domain shares 60% identity with SEQ ID NO:1, classified in class 435, subclass 7.4.
 - III. Claims 79-87 are drawn to a method of screening modulators wherein the tail domain shares 60% identity with amino acids 602 through 784 of SEQ ID NO:1, classified in class 435, subclass 7.6.
 - IV. Claims 88-101 are drawn to a method of screening modulators wherein the tail domain shares 60% identity with amino acids 1-357 of SEQ ID NO:1, classified in class 435, subclass 7.6.
2. Inventions II-IV and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, each group represents a different invention. Each group requires the use of a different reagent, wherein the different reagent are defined as: TL-gamma, TL-gamma with 60% identity to SEQ ID NO:1, a tail domain with 60% identity to amino acids 602-784 and a tail domain with 60% identity to amino acids 1-357. Because each

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group requires a different reagent, the method of screening associated with the reagent will cause a different mode of operation. The different reagents of groups I-IV will also provide different effects when comparing the method of screening for modulators because they require the use of different reagents.

Furthermore, the groups are drawn to a plurality of disclosed patentably distinct polypeptides comprising materially different amino acids. The separate amino acids bear distinct structural or biochemical properties. Therefore, each amino acid sequence disclosed is patentably distinct and is considered a separate invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1645

5. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing which inventions are obvious variants of each other or clearly admit on the record which inventions are obvious variants of each other. If the inventions are deemed obvious variants of each other, then if the examiner finds one of the inventions unpatentable over the prior art, the evidence submitted by applicant or admission of record by applicant may be used in a rejection under 35 U.S.C. §103(a) of the other inventions.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is (703) 305-0487. The examiner can normally be reached on Monday through Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Ja-Na Hines

April 18, 2001

JENNIFER E. GRASER
PRIMARY EXAMINER